

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action. With this Amendment, claim 38 has been amended, and claims 39, 47 and 48 have been cancelled. Reconsideration, examination and allowance of all pending claims are respectfully requested.

35 U.S.C. § 103(a) Rejections

On page 2 of the Office Action, the Examiner rejected claims 34-49 under 35 U.S.C. § 103(a) as being unpatentable over *Barbut et al.* (U.S. Patent No. 5,662,671) in view of *Macoviak et al.* (U.S. Patent No. 6,361,545) and *Samuels* (U.S. Patent No. 5,848,964). The Examiner states that *Barbut et al.* and *Samuels* each disclose the limitations of claim 34 except for a support hoop that is non-inflatable. The Examiner states, however, that *Macoviak et al.* suggest substituting a superelastic wire loop for an inflatable wire loop. According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to substitute the inflatable support hoop in *Barbut et al.* with a non-inflatable support hoop as suggested by *Macoviak et al.*

With respect to the rejection of claims 34-37, Applicants respectfully assert that it would not have been obvious to combine *Barbut et al.* or *Samuels* with the *Macoviak et al.* reference in arriving at an apparatus having a non-inflatable support with an articulation region. The *Barbut et al.* and *Samuels* references each disclose a catheter having an inflation lumen that is used to inflate or deflate an inflatable support member used to support a filter sac for capturing embolic material. *Barbut et al.*, for example, discloses a catheter (5) having first and second tubular passages (56,57) that can be used

to deliver gas and/or fluid to a donut-shaped chamber (71) of an inflation seal (70). *See Barbut et al.* at col. 13, lines 56-65. *Samuels*, in turn, discloses a catheter (14) having an inflation lumen (32) that can be used to inflate or deflate an inflatable cuff (12). *See Samuels* at col. 4, lines 42-46.

In order to support a claim of obviousness, the proposed modification to the prior art cannot render other elements of the invention inoperable for their intended purpose. In other words, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See* MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed Cir. 1984)).

Applicants respectfully assert that there would have been no motivation to substitute the inflatable support hoop in *Barbut et al.* or *Samuels* with the superelastic support hoop of *Macoviak et al.* since such combination would render the inflation lumens in *Barbut et al.* and *Samuels* inoperable for their intended purpose. With respect to the *Barbut et al.* reference, for example, the substitution of a non-inflatable support hoop for the inflation seal (70) described in that reference would render the first and second tubular passages (56,57) inoperable, thus suggesting that no motivation to combine references exists. Similarly, with respect to the *Samuels* reference, the substitution of a non-inflatable support hoop for the inflatable cuff (12) would also render the inflation lumen (32) described therein inoperable, likewise suggesting that no motivation to combine references exists. Accordingly, because the proposed modification would render the prior art being modified inoperable for its intended

purpose, Applicants respectfully assert that the obviousness rejection of claims 34-37 is improper.

With respect to the rejection of claims 38-39, Applicants have amended independent claim 38 to now recite a non-inflatable support hoop having an articulation region. Antecedent support for these claim limitations can be found in prior dependent claim 39 (now cancelled) and from previously presented claim 33 already considered by the Examiner. Applicants submit that no new matter has been added to the Application as a result of this Amendment.

For reasons similar to that provided above, Applicants respectfully assert that there would have been no motivation or suggestion to combine either *Barbut et al.* or *Samuels* with *Macoviak et al.* in arriving at the apparatus of claim 38 since such combination would render the tubular passageways/inflation lumens described therein inoperable for their intended purpose. Accordingly, Applicants respectfully assert that claim 38 is patentable over the cited prior art.

Finally, with respect to the rejection of claims 40-49, Applicants respectfully assert that none of the cited references appear to disclose or suggest a blood permeable sac slideably disposed on a guidewire, as recited in independent claim 40. The cited prior art references pertain to catheters and catheter system in which a blood permeable sac is affixed to a catheter shaft of a catheter for capturing emboli within a blood vessel. While a guidewire may be used in conjunction with the insertion and/or removal of these devices from the patient's body, the blood permeable sac disclosed in these references is not slideably disposed on a guidewire. Thus, since the cited prior art fails to disclose or

suggest each and every element of independent claim 40, Applicants respectfully assert that this claim is in condition for allowance.

Because independent claim 40 is allowable, Applicants assert that dependent claims 41-49 are also allowable for the reasons provided above and since they contained other elements not disclosed or suggested by the cited prior art.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance; issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

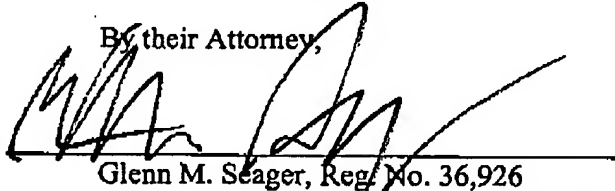
Respectfully submitted,

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By their Attorney,

Date:

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